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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/537,440

Applicant(s)

HUSEMANN ET AL.

Examiner

ANISH DESAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments in response to the Office action mailed on 08/21/08 have been fully considered.
2. The 35 USC Section 112-first paragraph rejections are withdrawn after reviewing Applicant's response (see page 6 of 12/30/08 amendment) which is found persuasive. However, in view of the amendment to claim 12, a new 35 USC Section 112-first paragraph rejection is made.
3. All of the previously made art rejections are maintained.
4. It is noted that claim 14 was previously rejected under 35 USC Section 103(a) as being obvious over Wallner (US 3,146,882) as applied to claim 1, and further in view of Craig et al. (US 6,299,799B1). The examiner confirms that this is technically incorrect since claim 14 depends from claim 4. Claim 14 should be correctly rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537) as applied to claims 1 and 4, and further in view of Craig et al. (US 6,299,799B1).

Claim Objections

5. Claim 14 is objected to because of the following informalities: the status identifier of claim 14 is "currently amended"; it should be changed to "previously presented" since the amendment to this claim was previously presented in 04/30/08 amendment. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4 and 12-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
7. Claim 12 recites "The antistatic...selected from the group consisting of electrically doped materials, electrically conductive polymers **and** electrically conductive organic salts...". This can be interpreted as said claim requiring either electrically doped materials **or** a combination of electrically conductive polymers **and** electrically conductive organic salts. Applicant's specification does not provide support for the electrically conductive materials are selected as a combination of "electrically conductive polymers **and** electrically conductive organic salts". It is noted that paragraph 0013 of the US Patent Application Publication 2006/0251892A1 of this application recites "The electrically conductive layer may likewise include...electrically conductive doped materials, electrically conductive polymers **or** electrically conductive organic salts...". Accordingly, the specification fails to provide support for the recitation "electrically conductive polymers **and** electrically conductive organic salts".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallner (US 3,146,882).
9. Wallner teaches an antistatic PSA tape comprising a backing coated with an antistatic primer layer (first electrically conductive primer layer), and a layer of PSA (first PSA) applied to the antistatic primer layer (column 1 lines 10-40). Moreover, Wallner is silent as to teaching the presence of electrically conductive particles in the PSA of his/her invention. Further, Wallner discloses polyacrylate adhesives at column 2 line 10.
10. **As to the newly added limitation of “wherein the first electrically conductive primer layer comprises electrically conductive materials”,** Wallner at column 1 lines 25-31 teaches that “It has been unexpectedly discovered that this static propensity can be overcome by utilizing a thin antistatic primer coating...**which is so compounded as to have substantial electrical conductivity.**” Further, as a compounding material, Wallner at column 2 lines 25-26 teaches antistatic polymers that are added to the primer layer. This disclosure of Wallner anticipates Applicant's claimed limitation of **electrically conductive primer comprising electrically conductive materials.** Accordingly, Wallner anticipates the claimed invention.

Claim Rejections - 35 USC § 102 or /103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1.
12. Although Wallner is silent as to teaching the first adhesive layer exhibits shrinkback, it is reasonable to presume that said feature of shrinkback is present in the adhesive tape of Wallner.
13. The support for said presumption is based on the fact that the adhesive tapes of Wallner and that of Applicant comprise a carrier layer, a first electrically conductive primer layer comprising electrically conductive materials between the carrier layer and a first PSA layer, wherein the PSA is free of electrically conductive particles. Additionally, the PSAs of Wallner and that of Applicant are similar; namely both comprise polyacrylates. Thus, the PSA tapes of Wallner and that of Applicant are structurally and compositionally equivalent. Therefore, the aforementioned claimed feature would necessarily be present in the invention of Wallner. The burden is shifted to Applicant to

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prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the PSA of Wallner is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977). Accordingly, Wallner anticipates or strongly suggests the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2-4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1 above, and further in view of Akhter (US 5,958,537).
15. Wallner is silent as to teaching claims 2-4 and 11-13.
16. However, Akhter discloses a static dissipative label (antistatic pressure-sensitive adhesive tape) comprising a backing film (carrier layer), at least one pressure-sensitive adhesive layer, and a primer layer containing electrically conductive particles (electrically conductive materials) that is between the carrier layer and the pressure-sensitive adhesive layer (abstract, column 1 lines 4-11, column 1 line 65 to column 2 lines 1-18, and Figure).

17. Regarding claims 2 and 11, the electrically conductive particles of Akhter are metal particles (column 3 lines 29-30). Additionally, regarding claims 2 and 11, the primer layer of Akhter comprises conductive polymers such as polyaniline (column 2 lines 5-13 and column 4 lines 1-3), which reads on electrically conductive conjugated polymers. Akhter further discloses the primer layer comprising conductive particles comprising (i) inorganic oxides coated with a conductive material (column 2 lines 5-13 and column 3 lines 29-67), which reads on the electrically doped material.

18. With regards to claim 3, the electrically conductive materials of Akhter are homogeneously dispersed throughout the binder resin matrix of the primer layer (column 2 lines 4-12).

19. Regarding claims 12 and 13, it is noted that Akhter discloses that typically the conductive particles (electrically doped materials) comprise at least about 30, preferably at least about 40 and more preferably at least about 50 weight percent of the combined weight of the binder resin and conductive particles (column 3 lines 44-47).

20. Additionally regarding claims 4 and 12; specifically regarding newly amended limitation "electrically conductive polymers and electrically conductive organic salts", the primary reference of Wallner's disclosure at column 2 lines 55-70 with respect to the organic polymer salts is interpreted to read on "electrically conductive organic salts". Further, Akhter discloses that the primer layer of his invention comprises conductive polymers such as polyaniline (column 2 lines 5-13 and column 4 lines 1-3), which reads on the electrically conductive conjugated polymers.

21. It is noted that the primary reference of Wallner discloses an antistatic PSA tape having a primer layer that is antistatic (electrically conductive). Wallner is silent as to teaching electrically conductive particles or electrically conductive materials such as that of claimed in claims 2-4 and 11-13. Secondary reference of Akhter discloses antistatic label which comprises a primer layer having electrically conductive materials including electrically conductive particles that meet requirements of claims 2-4 and 11-13.

22. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrically conductive materials including electrically conductive particles as required by claims 2-4 and 11-13 and as taught by Akhter, because selecting a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness (MPEP 2144.07).

23. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1 above, and further in view of Kitamura et al. (US 5,759,679).

24. Regarding claims 8 and 9, it is noted that Wallner is silent as to teaching the structure of the PSA tape as required by claims 8 and 9. Specifically, Wallner is silent as to teaching a second PSA layer connected to the carrier layer, a second electrically conductive primer layer between the second PSA and the carrier layer (claim 8), and the second PSA layer connected to the carrier layer as required by claim 9.

25. However, the reference of Kitamura is relied upon to show that such a structure of the PSA tape is known in the art. For example, Kitamura discloses an adhesive tape

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with foamed substrate (carrier) (abstract). Further, Kitamura discloses that the PSA layer can be applied on one or both sides of the foamed substrate (carrier) (column 7 lines 14-20). Additionally, Kitamura discloses that in order to improve the anchoring property of the PSA layers, an undercoat treatment (primer layer) is applied to the surface(s) of the carrier layer (column 7 lines 30-40). Additionally, Example 1-1 of Kitamura discloses application of undercoat to both sides of the carrier and application of PSA layers on both surfaces of the carrier layer.

26. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide PSA tape with the structure as presently claimed, motivated by the desire to form a suitable PSA tape.

27. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1 above, and further in view of Luhmann et al. (US 6,395,389B1).

28. Wallner is silent with respect to disclosing the PSA tape in the form of punched product. However, such punched tapes are known in the adhesive art as disclosed by Luhmann.

29. The invention of Luhmann is directed to an adhesive tape strip (see abstract). According to Luhmann "Typical presentation forms [of the adhesive tape] include, punched adhesive tape strip sections covered on one side with a release laminate...forms." (column 4 lines 28-45).

30. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape in the form of a punched product because doing so involves routine skill in the art.

31. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537) as applied to claims 1 and 4 above, and further in view of Craig et al. (US 6,299,799B1).

32. Wallner is silent with respect to teaching electrically conductive conjugated polymers are 3, 4 polyethylenedioxythiophene.

33. However, Craig discloses creamer compositions that are capable of being cured to form antistatic, abrasion resistant creamers. Further the creamer compositions of Craig comprise electrically conductive organic polymers (abstract). The creamer compositions of Craig can be coated onto a substrate that can be a part of a pressure-sensitive adhesive tape (column 4 lines 1-9). Further, Craig discloses 3,4 polyethylenedioxythiophene (3,4 PEDT), polyaniline, and polypyrrole as electrically conductive polymers (column 4 lines 33-37).

34. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use 3,4 polyethylenedioxythiophene in the invention of Wallner because selecting a known material based on its suitability for its intended use (purpose of providing static dissipation of charge) involves routine skill in the art.

35. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claims 1 and 5 above, and further in view of De Jonge et al. (US 6,284,837B1).

36. The invention of Wallner is previously disclosed. Wallner is silent with respect to teaching polymethacrylate PSA. However, De Jonge discloses PSA tapes and labels comprising polymethacrylate adhesives (see abstract and column 1 lines 35-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polymethacrylate PSA as taught by De Jonge in the invention of Wallner, motivated by the desire to use a suitable adhesive to form a PSA tape.

Response to Arguments

37. Applicant's arguments received on 12/30/08 have been fully considered but they are not found persuasive.

38. With respect to the 35 USC Section 102(b) rejections based on Wallner (US 3,146,882), Applicant argues that the presently claimed invention requires **electrically conductive materials** whereas Wallner teaches ionizable polymers (ionogenic polymers) which are different than electrically conductive materials.

39. The Examiner respectfully disagrees. Wallner at column 1 lines 25-31 teaches that "It has been unexpectedly discovered that this static propensity can be overcome by utilizing a thin antistatic primer coating...**which is so compounded as to have substantial electrical conductivity.**" Further, as a compounding material, Wallner at

column 2 lines 25-26 teaches antistatic polymers that are added to the primer layer.

Thus, this disclosure of Wallner anticipates Applicant's claimed limitation of the **electrically conductive primer comprising electrically conductive materials.**

40. Applicant further argues that his/her electrically conductive particles do not need moisture to function; whereas Wallner's ionic conductive materials do require moisture to function. This argument is not commensurate in scope with the claimed invention, because nothing in claims suggest "electrically conductive particles not requiring the moisture to function". Accordingly, the art rejections are sustained.

41. With respect to the 35 USC Section 102(b) or 103(a) rejection to claim 6 based on Wallner (US 3,146,882), Applicant argues that there is no basis for the presumption that the shrinkback is present in the adhesive tape of Wallner. This is not found persuasive for the following reasons:

42. It is noted that the adhesive tapes of Wallner and that of Applicant comprise a carrier layer, a first electrically conductive primer layer comprising electrically conductive materials between the carrier layer and a first PSA layer, wherein the PSA is free of electrically conductive particles (see column 1 lines 10-30 and Drawing of Wallner). Additionally, the PSAs of Wallner and that of Applicant are similar; namely both comprise polyacrylates (see column 2 lines 10-11 of Wallner).

43. Thus, the PSA tapes of Wallner and that of Applicant are structurally and compositionally equivalent. Therefore, it is respectfully submitted that the shrinkback would necessarily be present in the invention of Wallner. The burden is shifted to

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Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the PSA of Wallner is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977).

44. With respect to the 35 USC Section 103(a) rejections based on Wallner (US 3,146,882) in view of Akhter (US 5,958,537) to claims 2-4 and 11-13, Applicant argues that the Akhter reference discloses conductive particles within the primer layer and in the PSA layer. Therefore, a person of ordinary skill in the art would not be led to add conductive particles to the primer layer without also adding them to the PSA layer.

45. The Examiner respectfully disagrees for the following reasons:

46. It is noted that Wallner wants the PSA that is electrically insulative (see column 1 lines 44-45 and Drawing). Thus, one of ordinary skill in the art who is in the possession of Wallner and Akhter would not be motivated to add the electrically conductive particles of Akhter in the PSA of Wallner. Accordingly, Applicant's arguments are not found persuasive, and the art rejections are sustained.

47. With respect to the 35 USC Section 103(a) rejections based on Wallner (US 3,146,882) as applied to claim 1 and further in view of Kitamura et al. (US 5,759,679) to claims 8 and 9, Applicant generally makes same arguments that are made for Wallner's reference above. Thus, the Examiner has nothing more to add other than incorporating his rebuttal as set forth above with respect to Wallner reference here by reference.

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48. With respect to the 35 UCS Section 103(a) rejections based on Wallner (US 3,146,882) as applied to claim 1 and further in view of Luhmann et al. (US 6,395,389B1) to claim 10, Applicant generally makes same arguments that are made for Wallner's reference above. Thus, the Examiner has nothing more to add other than incorporating his rebuttal as set forth above with respect to Wallner reference here by reference. Accordingly, the art rejections are sustained.

49. With respect to the 35 USC Section 103(a) rejections based on Wallner (US 3,146,882) as applied to claim 1 and further in view of Craig et al. (US 6,299,799B1) to claim 14, Applicant argues that there is no reason to substitute electrically conductive polymers such as that of claimed by claim 14 and disclosed by Craig for Wallner's ionizable polymer salts.

50. The Examiner respectfully disagrees. Wallner at column 1 lines 25-31 teaches that "It has been unexpectedly discovered that this static propensity can be overcome by utilizing a thin antistatic primer coating...which is so compounded as to have substantial electrical conductivity." This is interpreted as Wallner desires that his primer be electrically conductive. Craig discloses a coating (creamer) that comprises electrically conductive polymers such as that of Applicant's claimed 3,4 PEDT (abstract, column 3 lines 55-67 to column 4 lines 1-40). Further, the creamer compositions of Craig can be coated onto a substrate that can be a part of a pressure-sensitive adhesive tape (column 4 lines 1-9). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use 3,4

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polyethylenedioxythiophene in the invention of Wallner because selecting a known material based on its suitability for its intended use (for the purpose of providing static dissipation of charge) involves routine skill in the art. Accordingly, Applicant's arguments are not found persuasive, and the art rejections are sustained.

51. With respect to the 35 USC Section 103(a) rejections based on Wallner (US 3,146,882) as applied to claim 1 and further in view of De Jonge et al. (US 6,284,837) to claim 15, Applicant generally makes same arguments that are made for Wallner's reference above. Thus, the Examiner has nothing more to add other than incorporating his rebuttal as set forth above with respect to Wallner reference here by reference. Accordingly, the art rejections are sustained.

Conclusion

52. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

53. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

54. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

55. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

56. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794